

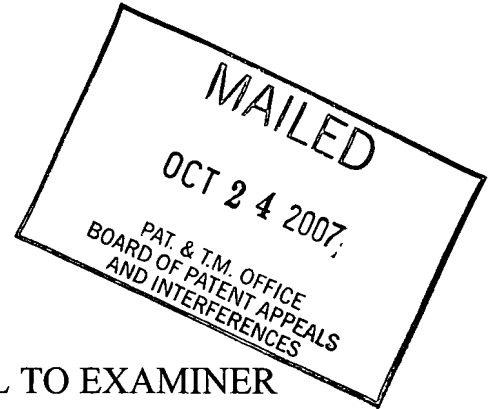
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAWSON A. WOOD

Application No. 10/649,932

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER



This application was received electronically at the Board of Patent Appeals and Interferences on October 6, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

On December 4, 2006, appellant filed a Supplemental Appeal Brief. On page 10, under the heading "Grounds of Rejection to be Reviewed on Appeal" the Appellants stated:

First Ground of Rejection: Claims 1, 5-7, 13, 14, 17, 21-24, 27, 28 and 33-36 stand rejected for obviousness on the basis of U.S. patent 6,385,596 to Wiser et al. in view of a publication entitled "The New Zealand Digital Library MELody index"" by McNab et al. These references will hereafter be called simply "Wiser" and "McNab."

Second Ground of Rejection: Claims 29-32 and 37 stand rejected for obviousness on the basis of **Wiser, McNab**, and U.S. patent 5,874,686 to Ghias et al. (hereafter simply "**Ghias**").

In response, an Examiner's Answer was mailed on June 14, 2007. While the Answer notes that "The appellant's statement of the grounds of rejection to be reviewed on appeal is correct" [page 2], the Examiner's Answer, the following § 103 rejections were made:

Claims 1, 5-7, 13-14, 17, 21-24, 27-28, 33-35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al. (hereafter "Wiser") [U.S. Pat. No. 6385596] in view of McNab et al. (hereafter "McNab") ["The New Zealand Digital Library MELody InDEX", May 1997]

Claims 29-32 and 37 are objected to as being dependent upon a rejection base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim

It appears as if the Examiner has withdrawn the 103 rejection to claims 29-32 and 37. However, the Examiner has not expressly done so in section (6) Grounds of Rejection Withdrawn subsection of the examiner's answer.

MPEP 1207.02 states in part;

The examiner should reevaluate his or her position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to**>in the "Grounds of Rejection Withdrawn" subsection of the examiner's answer<. This should be done even though any rejection not repeated and

discussed in the answer may be taken by the Board as having been withdrawn.
Ex parte Emm, 118 USPQ 180 (Bd. App. 1957).

And

(6) ****>***Grounds of Rejection to be Reviewed on Appeal*. A statement of whether the examiner agrees or disagrees with the statement of the grounds of rejection to be reviewed set forth in the brief and an explanation of any disagreement. Form paragraphs 12.154 and 12.154.01 or 12.154.02 may be used. In addition, the examiner must include the following subheadings (if appropriate):

(a) “Grounds of Rejection Withdrawn” - a listing of grounds of rejection under appeal that the examiner has withdrawn (form paragraph 12.154.05 may be used).

A clarification of which grounds of rejection have been maintained and those that have been withdrawn is required.


Application No. 10/649,932

Accordingly, it is

ORDERED that the application is returned to the Examiner;

- 1) to give a proper explanation of the grounds of rejection; and
- 2) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

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